REMARKS

Claims 36-45 are pending in the application.

The Examiner has made the following rejections:

1) claims 36-42 and 45 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 90-99 of copending and commonly owned application serial no. 09/517,999;

2) claims 36, 40 and 45 are rejected as being unpatentable under 35 USC 102(e) as being anticipated by Vancura U.S. Patent No. 6,033,307 ("Vancura");

3) claims 37, 38 and 39 are rejected under 35 USC 103(a) as being unpatentable over Vancura in view of Itkis U.S. Patent No. 4,856,787 ("Itkis");

4) claims 41-42 are rejected under 35 USC 103(a) as being unpatentable over Vancura in view of Acres U.S. Patent No. 5,836,817 ("Acres"); and

5) claims 43-44 are rejected under 35 USC 103(a) as being unpatentable over Vancura in view of Luciano, Jr. et al. U.S. Patent No. 6,050,895 ("Luciano").

Applicants are submitting herewith a terminal disclaimer in order to overcome the provisional rejection under the judicially created doctrine of obviousness-type double patenting. The

owners of 100% interest in the instant application are the inventors Troy DeFrees-Parrott and John Meekins. The aforementioned inventors are also the owners of 100% interest in copending application serial no. 09/517,999, filed on March 2, 2000. The terminal disclaimer fee is being paid by credit card and Credit Card Payment Form PTO-2038 is enclosed herewith.

Applicants have amended claims 36 and 45 to further patentably distinguish the claimed invention from the cited references. Specifically, Applicants have amended claim 36 to include the following elements or limitations:

a lottery gaming device to provide a lottery game, the lottery gaming device comprising:

A) a control module to operate the lottery gaming device in a first mode of operation wherein the lottery gaming device provides a lottery game based on lottery game data provided by a data source located within a casino or in a second mode of operation wherein the lottery gaming device provides a lottery game based on lottery game data provided by a remotely located data source located outside of the casino, and

B) interface circuitry in data communication with the control module, the interface circuitry receiving lottery game data from the data source located within the casino when the lottery game device is in the first mode of operation and lottery game data from the remotely located data source when the lottery game device is in the second mode of operation.

Support for this amendment is found in the instant specification at page 7, lines 2-7, page 9, lines 8-11, page 10, page 11, lines 4-7, and Figure 3. Anticipation requires that every element of the claimed invention be identically disclosed in a single reference. Corning Glass Works v. Sumitomo Electric, 9 U.S.P.Q. 2d 1962, 1965 (Fed. Cir. 1989). Vancura does not disclose or teach the lottery gaming device, control module and interface circuitry recited in amended claim 36. Therefore, Vancura does not anticipate amended claim 36. Consequently, claim 40, which depends from claim 36, is not anticipated by Vancura.

Applicants have amended claim 45 to include the following elements and/or limitations:

a lottery gaming device to provide a lottery game, the lottery gaming device comprising:

A) a control module to operate the lottery gaming device in a first mode of operation wherein the lottery gaming device provides a lottery game based on lottery game data provided by a data source located within a casino or in a second mode of operation wherein the lottery gaming device provides a lottery game based on lottery game data provided by a remotely located data source located outside of the casino, and

B) interface circuitry in data communication with the control module, the interface circuitry receiving lottery game data from the data source located within the casino when the lottery game device is in the first mode of operation and for receiving lottery game

data from the remotely located data source when the lottery game device is in the second mode of operation.

Support for this amendment is found in the instant specification at page 7, lines 2-7, page 9, lines 8-11, page 10, page 11, lines 4-7, and Figure 3. Vancura does not disclose or teach the lottery gaming device, control module and interface circuitry recited in amended claim 45. Therefore, Vancura does not anticipate amended claim 45.

Applicants also submit that Vancura, either taken alone or in combination with the other cited references, does not teach or suggest the invention as claimed in amended independent claims 36 and 45. "The showing of combinability, in whatever form, must nevertheless be clear and particular." (Winner International Royalty Corp. v. Wang, 53 U.S.P.Q.2d 1580 (Fed. Cir. 2000). It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the cited references so that the claimed invention is rendered obvious. In re Fritch, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Thus, obviousness cannot be established by locating references which describe various aspects of applicants' invention without also providing evidence of the motivating

force which would impel one skilled in the art to do what the applicants have done (see Ex parte Levengood, 28 U.S.P.Q.2d 1300 (BPAI 1993)). Here, there is no persuasive evidence of such a motivating force either in Vancura or in the combination of Vancura and any of the other cited references which would impel one skilled in the art to arrive at the invention as claimed in amended claims 36 and 45. Therefore, the invention as claimed in claims 36 and 45 is not rendered obvious by Vancura and the other cited references.

The Examiner has rejected claims 37-39 under 35 USC 103(a) as being unpatentable over Vancura in view of Itkis. Again, the mere fact that the Vancura and Itkis references may be modified in the manner suggested by the Examiner does not make the modification obvious unless the disclosures of Vancura and Itkis suggested the desirability of the modification. In re Fritch, 12 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992). There is no such suggestion to be found in the combination of the disclosures of Vancura and Itkis that would motivate one skilled in the art to arrive at the invention as claimed in claims 37-39. Therefore, Applicants submit that the combination of Vancura and Itkis does not render obvious the invention as claimed in claims 37-39.

Claims 41-44 depend directly or indirectly from independent claim 36. Since it has been shown that independent claim 36 is

patentable over Vancura, Applicants submit that claims 41-44 are patentable as well. Furthermore, Applicants submit that the combination of these dependent claims with independent claim 36 is not rendered obvious by Vancura and/or the other cited references.

Applicants have amended the claims to replace the term "drawing" with the term "game" in order to be consistent with the instant specification.

Applicants have added new claims 46, 47 and 48 which depend from independent claim 45. Claim 46 recites that the lottery game data source located in the casino comprises a casino computer system. Claim 47 recites that the casino gaming system further comprises a remotely located data source to provide the lottery game data. Claim 48 recites that the remotely located data source comprises a central lottery computer. It has been shown above the independent claim 45 is patentable over the cited references. Applicants submit that the cited references, either taken alone or in combination, do not teach or suggest the invention as claimed in claims 46, 47 and 48.

It is submitted in view of these amendments and remarks that all grounds for rejection have been removed. Reconsideration and allowance of this application are therefore earnestly solicited.

If the Examiner believes that the amendments to the claims do not distinguish the claimed invention from the cited references, then Applicants would like to schedule a telephonic interview with the Examiner and his Primary Examiner.

Respectfully submitted,

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